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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,922	03/16/2001	William L. Thomas	ODS-38	7120

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EXAMINER	
SKAARUP, JASON M	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/809,922	THOMAS, WILLIAM L.	
	Examiner	Art Unit	
	Jason Skaarup	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 05/25/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 3, 2005 has been entered.

Information Disclosure Statement

2. The Examiner considered the information disclosure statement (IDS) submitted on May 25, 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1- are rejected under 35 U.S.C. 102(e) as being anticipated by Schneier et al. (U.S. Patent No. 6,402,614).

Schneier et al. disclose a method and a system for using an interactive wagering application to allow a user in a particular location to participate in lottery wagering using user equipment as recited in claims 1 and 11, respectively. The disclosed method and system comprises:

determining the particular location of the user (col. 18, lines 1-7 and col. 18, line 55 to col. 19, line 25 and Figure 5 along with the related description thereof, wherein the HTV 20 includes GPS receiver 111 to communicate temporal and positional information);

providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user (col. 20, lines 27-34 and Figure 5 along with the related description thereof, wherein the CMC 12 enables/disables certain lottery games based on the temporal and positional information communicated by the GPS receiver 111 of HTV 20);

giving the user the ability to participate in at least one of the lotteries using the user equipment (col. 16, lines 22-37 and col. 20, lines 3-15, wherein the HTV 20 includes a touch screen display 84 enabling a user to participate in certain lottery games enabled by the CMC 12 based on the temporal and positional information communicated by the GPS receiver 111 of HTV 20).

Regarding claims 2 and 12, Schneier et al. disclose that the user equipment is configured to notify the user that results to at least one of the lotteries in which the user participated are available (col. 19, lines 54-64 and Figure 13 along with the related description thereof).

Regarding claims 3 and 13, Schneier et al. disclose that the notification is an instant message, a pager message or a telephone message (col. 10, lines 36-46, wherein a telephone network or an interactive communications network is used to facilitate game play in which the user is notified of lottery results, e.g., see col. 19, lines 54-64 and Figure 13 along with the related description thereof).

Regarding claims 4 and 14, Schneier et al. disclose that the user equipment is configured to display the results to at least one of the lotteries in which the user participated (col. 19, lines 54-64 and col. 20, lines 32-34, wherein display 84 of HTV 20 displays lottery results).

Regarding claims 5 and 15, Schneier et al. disclose that the user equipment is configured to indicate whether the user won for each of the lotteries for which results are displayed (col. 19, lines 54-64 and col. 20, lines 32-34, wherein display 84 of HTV 20 displays lottery results).

Regarding claims 6 and 16, Schneier et al. disclose that the user equipment is configured to record, in a multimedia format, the lottery drawings associated with the lotteries in which the user participated (col. 20, lines 40-56, wherein the messages containing lottery game outcomes, i.e., lottery drawings, contain text or graphics and can be orally communicated)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. (GB 2,147,773) and in view of Rittmaster (U.S. Patent Application Publication 2002/0023010).

Dickinson et al. discloses a method and a system for using an interactive wagering application to allow a user in a particular location to participate in lottery wagering using user equipment as recited in claims 1 and 11, respectively. The disclosed method and system comprises providing a listing of lotteries in which the user can participate on a visual display (Figures 1, 6-9B along with the related description thereof) and giving the user the ability to participate in at least one of the lotteries using the user equipment (Figures 1, 6-9B along with the related description thereof). However, Dickinson et al. does not explicitly disclose determining the particular location of the user and providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user. In a related gaming method and system, Rittmaster et al. teach limiting lotteries to geographic locations where such lotteries are legal (paragraphs [0006] and [0039]). Rittmaster et al. teach determining the particular location of the user (Figure 2 along with the related description thereof) and providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user (Figure 3 along with the related description thereof, wherein geographic information is used to allow or deny access to a product or service (i.e., the lottery listing of Dickinson). Rittmaster et al. teach that limiting lottery

availability based on geographic information determined from players helps to ensure lottery legality in certain jurisdictions (paragraph [0006]). It would have been obvious for one skilled in the art at the time of the invention to limit lottery availability based on geographic information determined from players as taught by Rittmaster et al. into the lottery method and system of Dickinson et al. to ensure lottery legality in certain jurisdictions as desirably taught by Rittmaster et al. in paragraph [0006].

7. Claims 2-5, 7, 9, 12-15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. in view of Rittmaster et al., as applied to claims 1 and 11 above, and further in view of LottoBot.

The combination of Dickinson et al. and Rittmaster et al. teaches a method and system as described above with respect to claims 1 and 11, respectively. However, the combination of Dickinson et al. and Rittmaster et al. does not explicitly teach various lottery functions recited in dependent claims 2-5, 7, 9, 12-15, 17 and 19. In a related lottery application, LottoBot teaches an analogous lottery system allowing users to access lottery data and play lottery games over the Internet through user equipment (pages 1 and 20-21). LottoBot further teaches that lottery results and winning numbers can be communicated to players as a convenience to the player (pages 20-21), which enables player's to check lottery results and winning numbers from their personal computers. It would have been obvious for one skilled in the art at the time of the invention to incorporate the notification of lottery results and winning numbers of LottoBot into the combination of Dickinson et al. and Rittmaster et al. in order to

increase player convenience by allowing players to check lottery results and winning numbers from their personal computers as desirably taught by LottoBot on pages 20-21.

Regarding claims 2 and 12, LottoBot teaches that users are notified that their lottery results are available through e-mail or pager message (page 1).

Regarding claims 3 and 13, LottoBot teaches that users are notified that their lottery results are available through pager message (page 1).

Regarding claims 4 and 14, LottoBot teaches displaying the results to at least one of the lotteries in which the user participated (page 1).

Regarding claims 5 and 15, LottoBot teaches indicating whether the user won for each of the lotteries in which the user participated (page 1).

Regarding claims 7 and 17, LottoBot teaches reminding a user of an upcoming lottery drawing, through jackpot alerts, with at least one of the lotteries in which the user participated (page 1).

Regarding claims 9 and 19, LottoBot teaches displaying a user interface to the user for use in creating a lottery wager, wherein the user interface is customized for each lottery (page 4).

8. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. in view of Rittmaster et al., as applied to claims 1 and 11 above, and further in view of Luciano et al. (U.S. Patent No. 6,168,521).

The combination of Dickinson et al. and Rittmaster et al. teaches a method and system as described above with respect to claims 1 and 11, respectively. In particular, the combination of Dickinson et al. and Rittmaster et al. teaches lottery game availability

based on geographic location, wherein users can play available lottery games. However, the combination of Dickinson et al. and Rittmaster et al. does not explicitly teach recording, in a multimedia format, the lottery drawings associated with the lotteries in which the user participated. In a related lottery application, Luciano et al. teach multiple player activated video terminals linked to computers (abstract). Each player places a wager and selects a particular lottery draw choices. The system enrolls the player in a future lottery game based on the choices. (abstract). After drawing winning lottery numbers, the system displays the result of the selected game displayed at the player's terminal in a multimedia format (see Figure 9 along with the related description thereof), such that the player can activate a stored replay of the draw (Figure 6 along with the related description thereof). Luciano et al. teach that the video lottery system provides more excitement and entertainment than traditional lottery systems (col. 1, lines 22-27). It would have been obvious for one skilled in the art at the time of the invention to incorporate the recordation of lottery results in a multimedia format presented to players of the lottery as taught by Luciano et al. into the lottery method and system as taught by the combination of Dickinson et al. and Rittmaster in order to increase player excitement and entertainment as desirably taught by Luciano et al. in col. 1, lines 22-27.

9. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. in view of Rittmaster et al., as applied to claims 1 and 11 above, and further in view of SGI Insights, Scientific Gaming International, vol. 1, issue no. 5 (hereafter "SGI Insights").

The combination of Dickinson et al. and Rittmaster et al. teaches a method and system as described above with respect to claims 1 and 11, respectively. In particular, the combination of Dickinson et al. and Rittmaster et al. teaches lottery game availability based on geographic location, wherein users can play available lottery games. However, the combination of Dickinson et al. and Rittmaster et al. does not explicitly teach generating lottery gift certificates. In a related lottery application, SGI Insights teaches the generation of lottery gift certificates for play in a future lottery (page 4). SGI Insights teaches that lottery gift certificates increase player appeal as recipients can use the gift certificates at any time, e.g., when the jackpot gets bigger (page 4). It would have been obvious for one skilled in the art at the time of the invention to incorporate the generation of lottery gift certificates as taught by SGI Insights into the lottery method and system as taught by the combination of Dickinson et al. and Rittmaster in order to increase player appeal to the lottery games provided thereby as desirably taught by SGI Insights on page 4.

10. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. in view of Rittmaster et al., as applied to claims 1 and 11 above, and further in view of McCollom et al. (U.S. Patent Application Publication 2002/001623).

The combination of Dickinson et al. and Rittmaster et al. teaches a method and system as described above with respect to claims 1 and 11, respectively. In particular, the combination of Dickinson et al. and Rittmaster et al. teaches lottery game availability based on geographic location, wherein users can create a wager based on user inputs

to play available lottery games (Figure 1 of Dickinson et al. along with the related description thereof). However, the combination of Dickinson et al. and Rittmaster et al. does not explicitly teach giving the user the ability to finalize the wager at a later time and reminding the user to finalize the wager, as recited in claims 10 and 20. It is notoriously well known to offer products and services over a network and to allow the purchaser of such products and services to finalize a purchase at a later time and/or be reminded to finalize the purchase. McCollom et al. teach an analogous networked system in which users are able to purchase items and coupons over a network, wherein the users are able to finalize their purchase at a later time and be reminded to finalize their purchase (Figures 13, 14 and 17 along with the related description thereof, wherein purchases are placed in a "shopping basket" or "wish list" for later purchase). The system display provides an indication reminding the purchaser that the purchase is not finalized (Figures 21 and 22 along with the related description thereof). McCollom et al. teach that finalizing purchases and reminding users of the same improves the system by allowing users to browse, assemble and store selections until electing to make a purchase (paragraphs [0132] to [0137]). It would have been obvious for one skilled in the art at the time of the invention to incorporate the ability for users or purchases to finalize a purchase and be reminded of the same as taught by McCollom et al. into the lottery method and system as taught by the combination of Dickinson et al. and Rittmaster in order to browse, assemble and store lottery selections until electing to make a purchase as desirably taught by McCollom et al. in paragraphs [0132] to [0137].

11. Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,325,716) in view of Archer (U.S. Patent No. 6,277,026).

Walker teaches a method as recited in claims 21 and 27. The disclosed method comprises giving the user the ability to set conditions via user equipment on which an interactive wagering application is partially implemented and automatically participating in the lottery on the behalf of the user when the conditions have been met. See col. 2:36-3:35. However, Walker employs paper tickets and does not explicitly teach electronic user equipment. Archer teaches an analogous system for selling lottery tickets online via electronic user equipment. See Figs. 1, 4A along with the related description thereof and col. 5:10-15. Archer teaches that the electronic user equipment facilitate the sale and distribution of lottery tickets online, which enhances revenues (col. 1:36-67). It would have been obvious for one skilled in the art at the time of the invention to incorporate the electronic user equipment as taught by Archer into the interactive wagering application of Walker et al. in order to facilitate the sale and distribution of lottery tickets which enhances revenues as desirably taught by Archer in col. 1:36-67.

Regarding claims 22 and 28, Walker teaches automatically participating in the lottery comprises using a default set of lottery numbers (col. 3:1-8; col. 5:1-19).

Regarding claims 23 and 29, Walker teaches default sets of lottery numbers are user-specified (col. 3:1-8; col. 5:1-19).

Regarding claims 24 and 30, Walker teaches automatically participating in the lottery comprises using a set of randomly generated lottery numbers (col. 3:1-8; col. 5:1-19).

Regarding claims 25 and 31, Walker teaches conditions based on factors selected from the group consisting of a period of time from the last time the user participated, the lottery prize, the odds of winning and any combination thereof (col. 2:54-3:1 and col. 4:11-27). In regard to the odds of winning, the Walker teaches enrolling a ticket based on a minimum payout, which determines the ticket's expected payout (i.e. odds of winning a particular payout).

Regarding claims 26 and 32, Walker teaches automatically participating in the lottery on behalf of the user every time the lottery is offered (col. 1:55-64 and col. 2:54-64).

Response to Arguments

12. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments filed May 3, 2005 with respect to claims 21-32 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious for one skilled in the art at the time of the invention to incorporate the electronic user equipment of Archer into the interactive wagering application of Walker et al. in order to facilitate the sale and distribution of lottery tickets which enhances revenues as desirably taught by Archer in col. 1:36-67.

Further, Applicant argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited (PTO-892).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jason Skaarup whose telephone number is 571-272-4455. The Examiner can normally be reached on Monday-Thursday (10:00-8:00).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Primary, Jessica Harrison can be reached at 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JESSICA HARRISON
PRIMARY EXAMINER